



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|------------------------|---------------------|------------------|
| 10/756,437 | 01/13/2004 | David E. Francischelli | P9912.03 | 2214 |
| 27581 | 7590 | 04/07/2005 | EXAMINER | |
| MEDTRONIC, INC. 710 MEDTRONIC PARKWAY NE MS-LC340 MINNEAPOLIS, MN 55432-5604 | | | ROANE, AARON F | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3739 | |

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/756,437

Applicant(s)

FRANCISCHELLI, DAVID E.

Examiner

Aaron Roane

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/27/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3, 5-16 and 18-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang et al. (USPN 6,527,767 B2).

Regarding claims 1,3, 5, 15, 18 and 19, Wang et al. disclose a method of ablation of an atrium of a heart of a patient, comprising: selecting a first elongated ablation component

(one jaw of 90) carrying a longitudinally extending first means (array of 68) for delivery of ablation energy and a second elongated ablation component (the other jaw of 90) and movable (see col. 8, line 45 through col. 9, line 9) relative to the first ablation component, wherein the first and second components are provided with means mounted to and extending along the first and second components for magnetically attracting the first and second ablation components toward one another along the length of the first means for delivery of ablation energy (magnets see col. 8, line 45 through col. 9, line 9); placing selected one of the first and second components along a first portion of tissue of the atrium on an external portion of the heart adjacent one or more pulmonary veins; placing the other of the first and second components along a second portion of tissue of the atrium on an external portion of the heart adjacent the one or more pulmonary veins to allow the magnetically attracting means to draw the first and second components toward one another to compress the first and second portions of tissue therebetween, along the length of the first and second components; and applying ablation energy (see col. 1-3 and col. 10). Wang et al. further disclose the attracting means comprises a magnet mounted to one of the first and second components, see col. 10 and figures 3-23. Finally, Wang et al. disclose the attracting means comprises an electromagnet, see col. 10 and figures 3-23.

Regarding claims 2 and 16, Wang et al. further disclose the second elongated ablation component carries a longitudinally extending second means for delivery of ablation energy, see col. 1-10 and figures 1-23).

Art Unit: 3739

Regarding claim 6, Wang et al. further disclose the attracting means comprises magnets mounted to both of the first and second components, see col. 10 and figures 3-23.

Regarding claims 7 and 20, Wang et al. further disclose the first and second components are rigid, see col. 3-11 and figures 3-23.

Regarding claims 8 and 21, Wang et al. further disclose the first component is rigid and the second component is sufficiently flexible to be deflected into alignment with the first component by the attracting means, see col. 3-11, figures 3-23 and claims 1 and 6.

Regarding claim 9, Wang et al. further disclose the first and second components are mounted to one another, see col. 3-11, figures 3-23 and claims 1 and 6.

Regarding claims 10, 11, 22 and 23, Wang et al. further disclose the first and second components are mounted to one another by means of a hinge and wherein allowing the magnetically attracting means to draw the first and second components toward one another to compress the first and second portions of tissue comprises pivoting the first and second components using the hinge, see col. 3-11, figures 3-23 and claims 1 and 6.

Additionally, Wang et al. further disclose the first and second components are mounted to jaws of an electrosurgical hemostat, see figures 3-23.

Regarding claim 12, Wang et al. further disclose the first and second components are not mounted to one another, see figure 13 wherein the first and second components are mounted to the distal end of 58.

Regarding claims 13, 14, 24 and 25, Wang et al. further disclose one of the first and second components is provided with a pre-formed curve, see figure 4. Additionally, Wang et al. disclose each of the first and second components is provided with a pre-formed curve, see figures 3-12 and 14-23.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. (USPN 6,527,767 B2) in view of Scheinman et al. (USPN 5,429,131).

Regarding claims 4 and 17, Wang et al. disclose the claimed invention except for the use of magnets comprised of a rare earth metal. Scheinman et al. disclose a magnetized electrode tip catheter and method of using the same comprising a first elongated ablation

component (48) carrying a longitudinally extending first means for delivery of ablation energy (50, 52 and electrical wires connecting electrodes and ablation energy source), a second elongated ablation component (see abstract) movable relative to the first elongated ablation component, and a means mounted (66) to and extending along the first and second ablation components for magnetically attracting the first and second ablation components toward one another along the length of the first means for delivery of ablation energy. Scheinman et al. teach that the magnetically attractive means may contain “any material or combination of materials which would create a magnetic attraction between the two” ablation components. Additionally, Scheinman et al. disclose that both “rare earth magnets” and/or “electromagnets” may be used, see col. 5, lines 43-65. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Wang et al., as taught by Scheinman et al., to use “any material or combination of materials which would create a magnetic attraction between the two” including magnets in the form of rare earth magnets and electromagnets.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

Art Unit: 3739

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.R. *A.R.*
April 4, 2005

Rosiland K. Rollins

ROSILAND K. ROLLINS
PRIMARY EXAMINER